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HAMILTON & TERRILE, LLP			ROSEN, NICHOLAS D	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/770,694	CONNORS ET AL.	
	Examiner Nicholas D. Rosen	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 August 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13,15-35,37,39-43,45-48,51-62 and 64-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-13,15-35,37,39-43,45-48,51-62 and 64-74 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 11 January 2006 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/30/2007</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claims 1-13, 15-35, 37, 39-43, 45-48, 51-62, and 64-74 have been examined.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 1, 2007 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-13, 15-23, and 73

Claims 1, 6, 19, and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430). As per claim 1, Smith discloses a computer system to provide one or more product selections to a user in accordance with an analysis of product related data provided by the user, the computer system comprising: a database storing product configuration information, wherein the product configuration information comprises product identifier information corresponding to product attribute information for multiple product configurations (column 7, lines 8-21; column 8, lines 43-62; and column 10, lines 14-27); and a processor (column 7, lines 1-7). Smith does not expressly disclose a memory to which the processor is coupled, but not only would the database require a memory, but Smith's disclosure of one or more computer programs running on a suitable computer processor or processors (column 7, lines 1-7) inherently requires a memory coupled to the processor wherein the one or more computer programs are stored. Smith further discloses receiving product related data from the user through a communication link coupled between a data processing system of the user and a data receiving module (column 7, line 63, through column 8, line 62); a filter service module to (i) receive one or more product attributes and (ii) identify one or more product configurations stored in the database that each include the one or more product attributes, if the product related data represents the one or more product attributes (column 10, lines 14-27); a configuration service module to (i) receive a product identifier and to (ii) identify each combination of attributes stored in the database that corresponds to the product identifier, if the product related data represents the product identifier (column 8, lines 24-62; column 10, lines 14-27); and a

presentation module to (i) provide each identified product configuration to the user via the communication link if the product related data represents the one or more product attributes (column 10, lines 14-27; Figure 5) and (ii) provide one or more product selections to the user via the communications link (column 8, lines 24-62; column 10, lines 14-27; Figure 5). Smith does not quite expressly disclose that, if the product related data represents the product identifier, each product selection represents a product identifier and a respective combination of attributes identified as corresponding to the product identifier, but the description of searching for a match or a near match for an identified product (column 8, lines 56-59) implies that the product selections each represent a product identifier and a respective combination of attributes identified as corresponding to the product identifier.

Smith does not disclose that the various modules are stored in the memory, but given a program of programs running on suitable computer processors, as disclosed, the sections of programming which cause Smith's system to carry out its functions can be viewed as modules stored in memory.

As per claim 6, Smith discloses that the database contains product identifier information that identifies each product configuration and reference data that links the one or more product attributes to a product configuration (column 8, lines 24-62; column 10, lines 14-27).

As per claim 19, Smith discloses that the database contains product identifier information (column 8, lines 24-62; column 10, lines 14-27).

As per claim 73, Smith discloses that the product related data includes data related to a vehicle (e.g., column 8, lines 24-42).

Claims 4, 5, 13, 15, 16, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430) as applied to claim 1 above, and further in view of official notice. As per claim 4, Smith does not expressly disclose a needs analysis module to process the received product related data, but some form of data processing would be inherent to enable the system to use the received product related data to search inventory, etc. Smith does not disclose that the needs analysis module determines which type of information is included in the received product related data, but official notice is taken that it is well known to determine which kind of information is included in data. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have a needs analysis module determine which type of information is included in the received product related data, for the obvious advantage of deciding what action to take in response to the product related data.

Smith does not expressly disclose that the filter service module is configured to provide a product identifier to said needs analysis module in response to one or more product attributes received from said needs analysis module, but discloses that a product is identified in response to a product attribute or attributes, and also that the product identifier identifies an existing (pre-generated) product, and the attribute information is an attribute of the product (column 8, lines 24-62; column 10, lines 14-27). Hence, it would have been obvious to one of ordinary skill in the art of electronic

Art Unit: 3625

commerce at the time of applicant's invention for the filter service to be appropriately configured, in order to carry out the disclosed functions of Smith's invention.

As per claim 5, Smith discloses that the filter service is configured to use said one or more product attributes to retrieve the product identifier from the database (column 8, lines 24-62; column 10, lines 14-27).

As per claim 13, Smith discloses permitting identification of at least one pre-generated product configuration based on product identifier information (column 8, lines 24-62; column 10, lines 14-27). For the obviousness of the needs analysis module, see the rejection of claim 4 above; official notice is taken that it is well known for computer programs to determine which module (e.g., subroutine) to provide data to.

As per claim 15, Smith does not expressly disclose that the configuration service module is configured to provide a configuration list to the needs analysis module in response to a product identifier received from the needs analysis module, but one can define whatever software module is involved in providing lists of the attributes of the various products in Smith's system as a configuration service, and Smith does disclose comparing product identifiers identifying products with configuration/attribute data for products, to determine which products match listed attributes (column 8, lines 24-62; column 10, lines 14-27). For the obviousness of the needs analysis module, see the rejection of claims 4 and 13 above; official notice is taken that it is well known for computer programs to determine which module (e.g., subroutine) to provide data to.

As per claim 16, Smith does not expressly disclose that said configuration list is a list of the available product attributes of said product, but such a list of available product

Art Unit: 3625

attributes would have been obvious for the purpose of enabling Smith's system to carry out its function of determining which, if any, available products match user-desired attributes (column 8, lines 24-62; column 10, lines 14-27).

As per claim 17, Smith does not expressly disclose that said configuration list is a list of the configurations of said product, but such a list of configurations would have been obvious for the purpose of enabling Smith's system to carry out its function of determining which, if any, available products match user-desired attributes (column 8, lines 24-62; column 10, lines 14-27).

As per claim 18, Smith does not expressly disclose that the configuration service is configured to use the product identifier to generate the configuration list from information stored in the database, but given that configuration/attribute information for products stored in the database are compared to attributes to determine which products match listed attributes (column 8, lines 24-62; column 10, lines 14-27), generating such configuration lists is held to be obvious, to make the system able to carry out its functions.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430) as applied to claim 1 above, and further in view of Neuborne et al. ("BRANDING ON THE NET: The Old Rules Don't Apply. So How Do You Hustle Those Wares Online?"). Smith does not disclose a software configuration engine stored in the memory to generate the pre-generated product configurations, but Neuborne teaches modifying product configurations by choosing options (paragraph beginning, "The program lets MasterCard slap its logo") which implies generating the basic

Art Unit: 3625

configurations, and perhaps the configurations as modified by options, if there are a limited number of options, leading to choices of vehicles configured in advance. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the computer system include a software configuration engine to generate the pre-generated product configurations, for the obvious advantage of being able to present configurations and options to a user.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430) as applied to claim 1 above, and further in view of Neuborne et al. ("BRANDING ON THE NET: The Old Rules Don't Apply. So How Do You Hustle Those Wares Online?"). Smith does not disclose that the data receiving module is further configured to receive data indicating a user selected product, wherein the selected product corresponds to one of the identified product configurations, and the data receiving module is further configured to receive product configuration selections from the user to further configure the selected product, but Neuborne teaches receiving product configuration selections from a user to further configure a selected product, and generating configured product data as selected (paragraph beginning, "The program lets MasterCard slap its logo"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the data receiving module thus configured, for the obvious advantage of enabling the user to configure the selected product according to his own wishes.

Neuborne does not expressly teach that the presentation module is further configured to present the configured product data to the user via the communication

Art Unit: 3625

link, but does teach an interactive design shop and an online order form; official notice is taken that it is well known to present descriptions of what is being purchased on online order forms. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to present the configured product data to the user via the communication link, for the obvious advantage of enabling the user to assure himself of what he had ordered.

Claims 7, 8, 9, 10, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430) as applied to claim 6 above, and further in view of the Microsoft Press Computer Dictionary. As per claim 7, Smith discloses the product configurations being pre-generated product configurations (column 8, lines 43-62). Smith does not disclose that the database comprises a configuration table storing the pre-generated product configurations, and an attribute table storing the product attribute information, but the Microsoft Press Computer Dictionary teaches the use of tables in databases (definition of table, senses 1 and 2, page 459). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the database comprise tables, specifically a configuration table and an attribute table, for the obvious advantage of linking relevant data, and enabling efficient access.

As per claim 8, Smith does not expressly disclose that the configuration table contains the product identifier, but the use of tables being obvious (as set forth above, regarding claim 7), storing this particular kind of information in the configuration table

would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention.

As per claim 9, Smith does not disclose that the tables comprise records comprising fields which contain corresponding information (attribute information in an attribute field, etc.), but the Microsoft Press Computer Dictionary teaches the use of fields in databases (definition of field, sense 1, page 194). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the tables comprise records comprising fields which contain corresponding information, for the obvious advantage of enabling data to be stored using standard techniques for easy storage and access.

As per claim 10, Smith discloses that said configuration information describes a configuration of a product; said attribute information describes an attribute of a product; and said configuration of said product includes said attribute of said product (column 8, lines 24-62), and for the product to actually exist in inventory, etc., its configuration must be allowable.

As per claim 11, Smith discloses that the needs analysis module is configured to access the configuration information through the filter service module (column 8, lines 24-62; column 10, lines 14-27).

As per claim 12, Smith discloses by inherency that a reference to a configuration record allows the filter service to access the configuration record according to attribute information, and therefore to access attribute records using attribute information (column 8, lines 24-42; column 10, lines 14-27).

Art Unit: 3625

Claims 20, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430) as applied to claim 19 above, and further in view of the Microsoft Press Computer Dictionary. As per claim 20, Smith does not disclose that the database comprises a configuration table containing said product identifier and said product configuration information, but the Microsoft Press Computer Dictionary teaches the use of tables in databases (definition of table, senses 1 and 2, page 459). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the database comprise a configuration table, specifically containing identifier information and configuration information, for the obvious advantage of linking relevant data, and enabling efficient access.

As per claim 22, Smith does not disclose that the configuration table comprises a configuration record comprising pre-generated product configurations and identifier fields which contain corresponding information, but the Microsoft Press Computer Dictionary teaches the use of fields in databases (definition of field, sense 1, page 194). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the configuration table comprise records comprising fields which contain corresponding information, for the obvious advantage of enabling data to be stored using standard techniques for easy storage and access.

As per claim 23, Smith discloses that said configuration information describes a configuration of the product, and product identifier information identifies the

Art Unit: 3625

configuration of the product (column 8, lines 24-42; column 10, lines 14-27). Smith further discloses can configure and save product configurations (column 10, lines 28-48).

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430) and the Microsoft Press Computer Dictionary as applied to claim 20 above, and further in view of official notice. Smith discloses that the needs analysis module is configured to access the configuration information, and that the configuration service module is configured to access the database (column 8, lines 24-42; column 10, lines 14-27). Smith does not expressly disclose that the needs analysis module supplies product identifier information to the configuration service (as well as to the user of the system), or that the configuration service module uses product identifier information to access the database. However, this is a mere verbal reshuffling. One can describe whatever module of Smith's system is involved in receiving the product identifier information (e.g., to be passed to the user) as a configuration service, and whatever module uses a product identifier to access the database (e.g., in comparing identified products to desired attributes) as a configuration service. For the obviousness of the needs analysis module, see the rejections of claims 4 and 13 above; official notice is taken that it is well known for computer programs to determine which module (e.g., subroutine) to provide data to.

Claims 24-35, 37, 39-48, and 74

Claims 24, 25, 37, and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430). Claims 24 and 74 are essentially

parallel to claims 1 and 73, respectively, and rejected on essentially the same grounds; claim 37 is narrower than claim 15, and rejected on similar grounds.

As per claim 25, Smith discloses a computer permitting identification of a product based on product attributes, implying code for doing so (column 8, lines 24-42; column 10, lines 14-48).

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith as applied to claim 24 above, and further in view of Neuborne. Claim 26 is essentially parallel to claims 3, and rejected on essentially the same grounds.

Claims 27, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith and Neuborne as applied to claim 24 above, and further in view of official notice. Claims 27, 28, and 29 are essentially parallel to claims 4, 5, and 6, respectively, and rejected on essentially the same grounds.

Claims 39, 40, 41, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith and as applied to claim 24 above, and further in view of official notice. AS per claim 39, Smith does not expressly disclose a needs analysis module to process the received product related data, but some form of data processing would be inherent to enable the system to use the received product related data to search inventory, etc. Smith does not disclose that the needs analysis module determines which type of information is included in the received product related data, but official notice is taken that it is well known to determine which kind of information is included in data. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have a needs analysis module

determine which type of information is included in the received product related data, for the obvious advantage of deciding what action to take in response to the product related data. Even this is unnecessary if one does not read a description of what a needs analysis module does from claim 4 (for example) into claim 39. Smith discloses a computer system analyzing needs (column 8, lines 24-42; column 10, lines 14-27), which implies that the code comprises a needs analysis module.

Claims 40-43 are closely parallel to claims 15-18, respectively, and rejected on essentially the same grounds.

Claims 30, 31, 32, 33, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Neuborne, and official notice as applied to claim 29 above, and further in view of the Microsoft Press Computer Dictionary. Claims 30, 31, 32, 33, and 35 are essentially parallel to claims 7, 8, 9, 10, and 12, respectively, and rejected on essentially the same grounds. As per claim 34, Smith discloses accessing product configuration identifier information using said attribute information (column 8, lines 24-42; column 10, lines 14-27).

Claims 45, 46, 47, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Neuborne, and official notice as applied to claim 29 above, and further in view of the Microsoft Press Computer Dictionary. As per claim 45, Smith discloses that the data structure contains product identifier information (column 8, lines 24-62; column 10, lines 14-27). Smith does not disclose that the data structure comprises a configuration table containing said product identifier information, but the Microsoft Press Computer Dictionary teaches the use of tables in databases (definition

of table, senses 1 and 2, page 459). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the database comprise a configuration table, for the obvious advantage of linking relevant data, and enabling efficient access.

As per claim 46, Smith discloses accessing the product configuration information, and accessing the database (column, 24-42; column 10, lines 14-27). Smith does not expressly disclose the code by supplying the product identifier information to a configuration server, and using the product identifier to access the database, but this is held to be mere verbal reshuffling. One can describe whatever module of Smith's system is involved in receiving the product identifier (e.g., to be passed to the user) as a configuration service, and whatever module uses a product identifier to access the database (e.g., in comparing identified products to desired attributes) as a configuration service.

As per claim 47, claim 47 is essentially parallel to claim 22, and rejected on essentially the same grounds.

As per claim 48, Smith discloses that the product configuration information describes a configuration of the product, and product identifier information identifies a pre-generated configuration of the product (column 8, lines 24-42; column 10, lines 14-27). For product configurations to be stored as packages (column 8, lines 40-42), and still more to actually exist in inventory (column 8, lines 44-62), the product configurations may be presumed to be allowable in accordance with applicable product rules governing allowable combinations of product attributes.

Claims 51-62 and 64-69

Claims 51, 52, 53, 57, 58, 59, 64, 65, 66, 67, 68, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430). As per claim 51, Smith discloses a method to provide one or more product selections to a user in accordance with product related data provided by the user, the method comprising: receiving the product related data from the user through a communication link coupled between a data processing system of the user and a computer system (column 7, lines 8-21; column 7, line 63, through column 8, line 62); receiving one or more product attributes and identifying one or more product configurations stored in a database that each include the one or more product attributes, if the product related data represents the one or more product attributes (column 10, lines 14-27); receiving a product identifier and identifying each combination of attributes stored in the database that corresponds to the product identifier, if the product related data represents the product identifier (column 8, lines 24-62; column 10, lines 14-27); providing each identified pre-generated product configuration as a product selection to the user via the communication link if the product related data represents the one or more product attributes (column 8, lines 43-62; column 10, lines 14-27). Smith does not quite expressly disclose that, if the product related data represents the product identifier, each product selection represents a product identifier and a respective combination of attributes identified as corresponding to the product identifier, but the description of searching for a match or a near match for an identified product (column 8, lines 56-59) implies that the product selections each represent a product identifier and a respective combination of attributes identified as corresponding to the product identifier.

As per claim 52, Smith discloses that the product identifier information identifies pre-generated product configurations, and the pre-generated product configuration represents a product having one or more of the attributes (column 8, lines 24-62).

As per claim 53, Smith does not expressly disclose causing a needs analysis module to provide said attribute to said filter service, and causing said filter service to return said product identifier to said needs analysis module, but this essentially follows from regarding the filter service as having a distinct needs analysis module, which amounts to designating certain circuits, or certain lines of computer code as a "needs analysis module." This need involve no substantive difference from Smith, and is therefore held to be obvious. (To make separable is considered to be within the level of ordinary skill in the art, *Nerwin v. Erlichman*, 168 USPQ 177, 179 [Board of Patent Appeals and Interferences, 1969]; *In re Dulberg*, 129 USPQ 348, 349; 289 F.2d. 522 [CCPA 1961].)

As per claim 57, Smith discloses providing the product identifier to a configuration service; identifying the pre-generated product configuration corresponding to the product identifier by causing the configuration service to query a database using the product identifier; and causing the configuration service to return the identified pre-generated product configuration (column 8, lines 24-62; column 10, lines 14-36).

As per claim 58, the product configurations are pre-generated product configurations, and the product identifier is associated with a pre-generated product configuration in the database (column 8, lines 24-62; column 10, lines 14-36).

As per claim 59, claim 59 is rejected as obvious on essentially the same basis as claim 53. Smith does not expressly disclose causing a needs analysis module to provide said product identifier information to said filter service, and causing said filter service to return said pre-generated product configuration to said needs analysis module, but this essentially follows from regarding the filter service as having a distinct needs analysis module, which amounts to designating certain circuits, or certain lines of computer code as a "needs analysis module." This need involve no substantive difference from Smith, and is therefore held to be obvious. (To make separable is considered to be within the level of ordinary skill in the art, *Nerwin v. Erlichman*, 168 USPQ 177, 179 [Board of Patent Appeals and Interferences, 1969]; *In re Dulberg*, 129 USPQ 348, 349; 289 F.2d. 522 [CCPA 1961].)

As per claim 64, Smith discloses that the product related data includes data related to a vehicle (e.g., column 8, lines 24-42).

As per claim 65, Smith discloses that the product configuration selections comprise a make of said vehicle (e.g., column 8, lines 24-42).

As per claim 66, Smith discloses that the product configuration selections comprise a model of said vehicle (e.g., column 8, lines 24-42).

As per claim 67, Smith discloses that the product configuration selections comprise a trim level of said vehicle (e.g., column 8, lines 24-42).

As per claim 68, Smith discloses that the product configuration selections comprise an equipment level of said vehicle (e.g., column 8, lines 24-42).

As per claim 69, Smith discloses that the product configuration selections comprise one of a price range, a vehicle type, an engine type, a fuel economy, an interior feature, and a safety feature (e.g., column 8, lines 24-42).

Claims 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith as applied to claim 51 above, and further in view of the Microsoft Press Computer Dictionary. As per claim 54, Smith discloses querying a database of the computer system (column 8, lines 24-42); identifying at least one database record comprising the product identifier and attribute identification; and identifying a pre-generated product configuration associated with attribute information (column 8, lines 24-62). Smith does not disclose accessing an attribute table of said database using said one or more attributes; and accessing said product database record in a configuration table of said database, but the Microsoft Press Computer Dictionary teaches the use of tables in databases (definition of table, senses 1 and 2, page 459). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the database comprise an attribute table and a configuration table, and access those tables, and the data therein, for the obvious advantage of linking relevant data, and enabling efficient access.

As per claim 55, Smith discloses that the product identifier is associated with the pre-generated product configuration, and each pre-generated product configuration represents a product having said one or more attributes (column 8, lines 24-62).

As per claim 56, claim 56 is rejected on the same basis as claim 54.

Claims 60 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith as applied to claim 57 above, and further in view of the Microsoft Press Computer Dictionary. As per claim 60, Smith does not disclose accessing a configuration table of said database using product identifier to identify said pre-generated product configuration, but the Microsoft Press Computer Dictionary teaches the use of tables in databases (definition of table, senses 1 and 2, page 459). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the database comprise a configuration table, and access that tables, and the data therein, for the obvious advantage of linking relevant data, and enabling efficient access.

As per claim 61, Smith discloses that each pre-generated product configuration is associated with a product identifier (column 8, lines 24-62; column 10, lines 14-36).

Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430) and official notice as applied to claim 51 above, and further in view of Neuborne et al. ("BRANDING ON THE NET: The Old Rules Don't Apply. So How Do You Hustle Those Wares Online?"). Smith discloses receiving data indicating a user selected product, wherein the selected product corresponds to one of the identified pre-generated product configurations (column 8, lines 40-62). Smith does not disclose receiving product configuration selections from the user to further configure the selected product, but Neuborne teaches receiving product configuration selections from a user to further configure a selected product, and generating configured product data as selected (paragraph beginning, "The program lets MasterCard slap its logo"). Hence, it

Art Unit: 3625

would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to receive such selections, for the obvious advantage of enabling the user to configure the selected product according to his own wishes.

Neuborne does not expressly teach generating configured product data corresponding to the product configuration selections configured product data to the user via the communication link, but does teach an interactive design shop and an online order form; official notice is taken that it is well known to present descriptions of what is being purchased on online order forms. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to generate such configured product data, and present the configured product data to the user via the communication link, for the obvious advantage of enabling the user to assure himself of what he had ordered.

Claims 70-72

Claims 70 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430). As per claim 70, Smith discloses an apparatus to provide one or more product selections to a user in accordance with product related data provided by the user, the apparatus comprising: means for receiving the product related data from the user through a communication link coupled between a data processing system of the user and a computer system (column 7, lines 8-21; column 7, line 63, through column 8, line 62); means for processing the received product related data using resources of the computer system (column 7, lines 1-7; column 8, lines 24-62); means for receiving one or more product attributes and identifying one or more pre-

generated product configurations stored in a database that each include the one or more product attributes, if the product related data represents the one or more product attributes (column 10, lines 14-27); receiving a product identifier and identifying each combination of attributes stored in the database that corresponds to the product identifier, if the product related data represents the product identifier (column 8, lines 24-62; column 10, lines 14-27); and means for providing each identified pre-generated product configuration as a product selection to the user via the communication link if the product related data represents the one or more product attributes (column 8, lines 43-62; column 10, lines 14-27). Smith does not quite expressly disclose that, if the product related data represents the product identifier, each product selection represents a product identifier and a respective combination of attributes identified as corresponding to the product identifier, but the description of searching for a match or a near match for an identified product (column 8, lines 56-59) implies that the product selections each represent a product identifier and a respective combination of attributes identified as corresponding to the product identifier.

As per claim 72, Smith discloses that the product related data includes data related to a vehicle (e.g., column 8, lines 24-42).

Claim 71 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430) as applied to claim 70 above, and further in view of Neuborne et al. ("BRANDING ON THE NET: The Old Rules Don't Apply. So How Do You Hustle Those Wares Online?") and official notice. Smith discloses receiving data indicating a user selected product, wherein the selected product corresponds to one of the identified

Art Unit: 3625

pre-selected product configurations (column 8, lines 40-62). Smith does not disclose receiving product configuration selections from the user to further configure the selected product, but Neuborne teaches receiving product configuration selections from a user to further configure a selected product, and generating configured product data as selected (paragraph beginning, "The program lets MasterCard slap its logo"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the apparatus comprise means for receiving such selections, for the obvious advantage of enabling the user to configure the selected product according to his own wishes.

Neuborne does not expressly teach generating configured product data corresponding to the product configuration selections configured product data to the user via the communication link, but does teach an interactive design shop and an online order form; official notice is taken that it is well known to present descriptions of what is being purchased on online order forms. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the apparatus comprise means for generating such configured product data, and presenting the configured product data to the user via the communication link, for the obvious advantage of enabling the user to assure himself of what he had ordered.

It is noted that claims 70-72 use "means for" language. Nonetheless, they are not treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant wishes to invoke 35 U.S.C. 112, sixth paragraph, Applicant should provide an explicit statement to that effect. 35 U.S.C. 112, sixth paragraph states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Response to Arguments

Applicants' arguments filed March 1, 2007, have been fully considered but they are not persuasive. Applicants take issue with Examiner's description of Smith's invention, "As per column 8 of Smith, a consumer may specify leather seats, a V10 engine, and other attributes, leading to a vehicle which matches, or near-matches, the entered criteria being selected; or the consumer may identify a vehicle as a Ford Excursion, with other identifying information, and have a matching vehicle be recommended" (emphasis added by Applicants). Applicants submit that Smith actually teaches identifying a set of attributes and identifying a vehicle with other identifying information and having a match recommended. Examiner replies that the customer in Smith's system can do this, but Smith does not preclude the customer specifying a set of attributes and in response receiving the selection of a vehicle which matches, or near-matches, the entered criteria. There is, Examiner agrees, a difference of emphasis between Smith and Applicants' claimed invention, but that does not suffice to make Applicants' claimed invention non-obvious.

The Supreme Court has ruled in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007) that the teaching, suggestion or motivation test should not be applied as a rigid and mandatory formula that limits obviousness analysis through a

Art Unit: 3625

formalistic conception of the words "teaching," "suggestion," and "motivation" or by overemphasis on the importance of published articles and explicit content of issued patents, since market demand, rather than scientific literature, often drives design trends, and granting patent protection to advances that would occur "in the ordinary course" without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility (1385-1386).

To quote further from *KSR* (at 1386), "[R]igid application of preventative rules that deny fact finders recourse to common sense are neither necessary nor consistent with precedent."

The Court also noted in the *KSR* decision (1386), "[I]f there is design need or market pressure to solve [a] problem, and there are [a] finite number of identified, predictable solutions, [a] person of ordinary skill in art has good reason to pursue known options within his or her technical grasp, and if this leads to anticipated success, it is likely product of ordinary skill and common sense, not innovation."

Examiner holds that there is market pressure to solve the problem of finding or recommending items of merchandise which people will want to buy, and there are a finite number of identified, predictable solutions, including identifying a set of desired attributes and identifying a product, such as a vehicle, by inputting identification information. Applying either of these leads to anticipated success, and amounts to uniting old elements with no change in their respective functions so as to yield

predictable results. Therefore, doing so is held to have been obvious to one of ordinary skill, when the circumstances are considered in light of the *KSR* ruling.

The common knowledge or well-known in the art statements in the previous office action are taken to be admitted prior art, because Applicant did not traverse Examiner's taking of official notice.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Franciscus de Heer et al. (U.S. Patent 7,197,479) disclose methods and apparatus for implemental a multilingual catalog system.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3625

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith, can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER

September 21, 2007